Appl. No. 10/731,655
Amdt. dated September 1, 2006
Reply to Office Action of June 1, 2006

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REMARKS/ARGUMENTS

Claims 1-26 are pending in this Application.

Claims 8, 16, and 19-26 are currently amended. Claims 1-26 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-26 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 19-25 stand rejected under 35 U.S.C. § 101 as being software per se. Claims 1-3, 7, and 9-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2001/0002485 to Bisbee et al. (hereinafter "Bisbee"). Claims 4, 5, and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisbee, in view of U.S. Patent No. 6,366,934 to Cheng et al. (hereinafter "Cheng"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisbee, in view of Official Notice. Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisbee, in view Cheng, and in further view of Official Notice.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on 35 U.S.C. § 112, second paragraph. In the Office Action, claims 1, 7, 12, 19, and 26 stand rejected under 35 U.S.C. § 112, second paragraph as the relationships in the corresponding claims between a first recited electronic signature and a second recited electronic signature is allegedly unclear. 35 U.S.C. § 112, second paragraph sets forth two separate requirements: 1) the claims must set forth the subject matter that applicants regard as their invention; and 2) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. The primary purpose of the second requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.

Applicants submit that the scope of claims 1, 7, 12, 19, and 26, and is sufficiently definite and clear to one ordinarily skilled in the art. For example, one ordinarily skilled in the

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art would understand the feature recited in claim 1 of "executing a rule associated with the record to determine whether an electronic signature is required to connote review and/or approval of the electronic record" to mean executing the rule to determine whether <u>any</u> electronic signatures are required. Furthermore, one ordinarily skilled in the art would understand the feature recited in claim 1 of "if execution of the rule results in a determination that an electronic signature is required, requesting the electronic signature prior to committing the transaction to the database" to mean that if execution of the rule to determine whether <u>any</u> electronic signatures are required results in a determination whether <u>a particular</u> electronic signature is required, the particular electronic signature is requested prior to committing the transaction to the databases. Thus, Applicants submit that the scope of claims 1, 7, 12, 19, and 26, and is sufficiently definite and clear.

The Office Action also rejected claim 8 due to antecedent basis. In response, Applicants have amended the corresponding claims.

The Office Action further alleges that the term "unstructured data" in claims 4, 5, 6, 8, 15, 16, 22, and 23 is a relative term which renders the claim indefinite. The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). The Office Action correctly notes that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Applicants submit that one of ordinary skill in the art would understand what is claimed by the term "unstructured data." Structured data and unstructured data have meaning to those ordinarily skilled in the art. Applicants submit that one ordinarily skilled in the art would understand the term "structured data" to mean information found in databases. Since the database fields are clearly defined, it is easy to run queries and formulas that extract meaningful information, not just raw data. Applicants further submit that one ordinarily skilled in the art would understand the term "unstructured data" to mean what we find in emails, reports, PowerPoint presentations, voice mail, phone notes, agendas, and photographs. Typically, the entire spectrum of data that is less structured than database entries is categorized under the term

"unstructured data." Applicants further submit that one ordinarily skilled in the art would understand that data with some form of structure may also be referred to as unstructured data if the structure is not helpful for a desired processing task. For example, an HTML webpage is highly structured, but this structure is often oriented towards formatting of content, rather than performing more complex processing tasks on the content formatted by the HTML.

Applicants direct the Examiner's attention to the following resources for more information on unstructured vs. structured data: http://en.wikipedia.org/wiki/Unstructured_data; http://www.enterpriseitplanet.com/storage/features/article.php/3407161; http://www.destinationkm.com/articles/default.asp?ArticleID=1049.

Therefore, Applicants submit that one ordinarily skilled in the art would understand the meaning of unstructured data in light of the specification. Applicants further submit that the use of the term unstructured data in the Specification is consistent with the understanding of one ordinarily skilled in the art. For example, in one embodiment, a system shown in Applicants' FIG. 1B includes an evidence store, which stores unstructured data that includes a well-formed XML document stored within a single table or column of a database in the evidence store. While each XML document adheres to a structure (e.g., a particular DTD) and in one sense is thus structured data, the database column the XML document is stored in the evidence store is unstructured in the sense that it can store XML data that adheres to a variety of DTDs and thus is not limited to storing data that adheres to a particular structure. (Application: Paragraph 0048). Thus, Applicants submit that one of ordinary skill in the art would understand what is claimed by storing "unstructured data" as recited in the corresponding claims, in light of the specification. Thus, Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 101

The Office Action rejected claims 19-25 under 35 U.S.C. § 101 as being software per se. In response, Applicants have amended the claims. Therefore, Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on 35 U.S.C. § 101.

Claim Rejections Under 35 U.S. C. § 102(b)

Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on Bisbee. The Office Action alleges that Bisbee teaches or suggests all of the claimed limitations of claims 1-3, 7, and 9-25. To anticipate a pending claim, a prior art reference must provide, either expressly or inherently, each and every limitation of the pending claim. (M.P.E.P. § 2131). Applicants respectfully submit that Bisbee fails to disclose at least one of the claimed limitations recited in each of the corresponding claims.

Claim 1

Claim 1 recites a method of committing a transaction to a database. The method recited in claim 1 includes initiating a database transaction. As recited in claim 1, an electronic record is created that includes transaction data from the database transaction. As further recited in claim 1, a rule associated with the record is executed to determine whether an electronic signature is required to connote review and/or approval of the electronic record. If execution of the rule results in a determination that an electronic signature as recited in claim 1, the electronic signature is requested prior to committing the database transaction to the database.

Applicants submit that Bisbee does not teach or suggest the above-recited features of claim 1.

Bisbee is directed to solving problems with authentication of electronic documents. (Bisbee: Paragraph 0027). In Bisbee, digital signatures are not valid indefinitely, but only during the validity period of their authentication certificates, which expire to limit the chances for compromise. Thus, in Bisbee, a time stamp, a digital signature, and an authentication certificate of a trusted custodial utility is applied to electronic records with validated authentication information. This extends the validity of the stored electronic record to the validity period of the applied authentication certificate.

Bisbee, however, has nothing to do with a method of committing a transaction to a database as recited in claim 1. Instead, Bisbee merely mentions the use of a database to store data. (Bisbee: Paragraph 71, where the contents can be one or more information objects, each comprising ...databases...etc.; Paragraph 104; Paragraph 198, where the object-inventory itself

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is an e-original that includes metadata that are details characterizing the deal and selection criteria used to locate the deal in the system and that includes <u>one or more database references</u> used for retrieving the individual e-originals pertaining to the deal and the TCU's signature block in each e-original; FIG. 6, see business rules database.) Merely mentioning that stored data may be in a database does not teach or suggest the method of committing a transaction to a database as recited in claim 1.

  Further, Applicants submit that Bisbee does not teach or suggest "creating an electronic record that includes transaction data from the database transaction" as recited in claim 1. FIG. 7, element 702 of Bisbee discloses the creation of electronic records. Instead of creating an electronic record that includes transaction data from the database transaction as recited in claim 1, in Bisbee, documents are created with a word processor. The word-processed documents then are executed by applying holographic signatures to paper records. The paper records are then converted to electronic records by scanning. (Bisbee: FIG. 7; Paragraph 0170). Creating an electronic record using a word processor and scanning a paper document in Bisbee is substantially different from creating an electronic record <u>that includes transaction data from a database transaction</u> as recited in claim 1. The process of creating electronic records in Bisbee does not teach or suggest "creating an electronic record that includes transaction data from the database transaction" as recited in claim 1.

  Applicants respectfully disagree with the Office Action that cites Paragraph 93 of Bisbee for its teaching as allegedly disclosing the features of "initiating a database transaction" and "creating an electronic record that includes transaction data from the database transaction" as recited in claim 1. Paragraph 93 of Bisbee describes FIG. 4 of Bisbee, which is a flow chart of a method of <u>creating an object-inventory</u> for a respective deal. Paragraph 93 and FIG. 4A of Bisbee further disclose that <u>an object inventory is a list of object identifiers and associated signature blocks for e-originals corresponding to a deal</u>. A "deal" in Bisbee refers to <u>a transaction or account</u> that corresponds to or is defined by a set of e-originals. (Bisbee: Paragraph 0076]. A transaction or account in Bisbee is a business transaction or business account, which are both substantially different from a database transaction as recited in claim 1. Additionally, the object inventory of Bisbee does not teach or suggest an electronic record as

recited in claim 1. In Bisbee, the object inventory is created from a list of identifiers and

signature block, which do not teach or suggest creating an electronic record that includes

transaction data from a database transaction as recited in claim 1.

   Moreover, Applicants submit that Bisbee does not teach or suggest the feature of

"executing a rule associated with the record to determine whether an electronic signature is

required to connote review and/or approval of the electronic record, wherein if execution of the

rule results in a determination that an electronic signature is required, requesting the electronic

signature prior to committing the database transaction to the database" as recited in claim 1.

Instead, FIG. 6, element 610 of Bisbee shows that business rules are used to identify 1)

electronic record types, 2) electronic records that will be transferable records, 3) user types who

can do what to which electronic record types (i.e., user permissions), 4) action required for

identified electronic record types to become transferable records, and 5) electronic record types

required to conclude deal.

   The rules in Bisbee identifying electronic record types clearly do not teach or

suggest a rule associated with the record to determine whether an electronic signature is required

to connote review and/or approval of the electronic record as recited in claim 1. Nowhere does

Bisbee make a correlation between types of electronic records and a determination whether any

electronic signatures are required to connote review and/or approval of the electronic record as

recited in claim 1. The rules identifying electronic records that will be transferable records in

Bisbee clearly do not teach or suggest a rule associated with the record to determine whether an

electronic signature is required to connote review and/or approval of the electronic record as

recited in claim 1. In Bisbee, the determination whether an electronic record of Bisbee is

transferable allows <u>transfer</u> of the record, and does not teach or suggest a determination whether

an electronic signature is required to connote <u>review and/or approval</u> of the electronic record as

recited in claim 1. Additionally, rules identifying electronic record types required to conclude a

deal in Bisbee clearly related to <u>the deal</u>, and do not teach or suggest a rule associated with the

record to determine whether an electronic signature is required to connote <u>review and/or</u>

<u>approval of the electronic record</u> as recited in claim 1. The determination in Bisbee whether an

electronic record is required or not <u>to conclude a deal</u> is different from a determination whether

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an electronic signature is required <u>to connote review and/or approval of the individual electronic</u> <u>record</u> as recited in claim 1.

Furthermore, Applicants submit that none of the remaining rules in Bisbee are associated with a record to determine whether an electronic signature is require to connote review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a database as recited in claim 1. FIG. 9 of Bisbee shows that a user applies a digital signature to an electronic record in step 926. Then, in steps 930 and 936, the business rules in Bisbee are checked <u>after</u> the digital signature has been applied. The execution of business rules after applying a digital signature in Bisbee does not teach or suggest executing a rule associated with a record to determine whether an electronic signature is require to connote review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a database as recited in claim 1. The process of executing rules in Bisbee is substantially different from executing a rule associated with a record to determine whether an electronic signature is require to connote review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a database as recited in claim 1.

Based on the above, Applicants respectfully disagree with the Office Action that cites Paragraph 40 and Paragraphs 190 and 191 of Bisbee for its teach as allegedly disclosing the feature of "executing a rule associated with the record to determine whether an electronic signature is required to connote review and/or approval of the electronic record, wherein if execution of the rule results in a determination that an electronic signature is required, requesting the electronic signature prior to committing the database transaction to the database" as recited in claim 1. Paragraph 40 of Bisbee merely discloses the types of rules discussed above which have nothing to do with determining whether an electronic signature is require to connote review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a database as recited in claim 1. Additionally, Paragraphs 190 and 191 of Bisbee have nothing to do with determine whether an electronic signature is require to connote review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a database as recited in claim 1. Paragraphs 190 and 191 of Bisbee merely discuss the use of signature blocks and wrappers which have nothing to do with determining whether an electronic signature is require to connote

review and/or approval of the electronic record <u>prior</u> to committing a database transaction to a
database as recited in claim 1.

      In light of the above, Applicants submit Bisbee does not teach or suggest at least
the above-discussed claim limitation, and others. Applicants further submit that claim 1 is
therefore allowable.

      <u>Claims 2-26</u>

      Applicants submit that independent claims 12, 19, and 26 are allowable for at
least a similar rationale as discussed above for the allowability of claim 1, and others.
Applicants submit that dependent claims 2-11, 13-18, and 20-25 that depend directly and/or
indirectly from the independent claims 1, 12, and 19 respectively, are also allowable for at least a
similar rationale as discussed above for the allowability of the independent claims. Applicants
further submit that the dependent claims recite additional features that make the dependent
claims allowable for additional reasons.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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